

## **REMARKS**

Claims 1-23 are pending. Claims 9, 16, and 20 are currently amended. No new matter has been added.

Claims 9 and 16 are amended to more particularly point out that the retractor system in claims 9 and 16 comprises a “frame.”

Claim 20 is amended to more particularly point out that the tissue retracting surfaces are moved apart from one another “independently of the first and second guides.”

No new matter has been added by these amendments.

### ***Double Patenting Rejections***

Claims 1-19 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7,014,608. If claims eventually found to be allowable in the present application give rise to proper double patenting rejections of this nature, Applicants will submit a Terminal Disclaimer to overcome such rejections.

### ***Rejections under 35 U.S.C. § 112***

Claims 9, 10, and 16 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As claims 9 and 16 are amended to more particularly point out that the retractor system in claims 9 and 16 comprises a “frame,” Applicants submit these rejections are moot.

### ***Rejections under 35 U.S.C. § 103***

Claims 1-7, 11, 14, 15, 17-18, and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,944,658 to Koros et al. (“Koros”) in view of U.S. Patent No. 6,354,995 to Hoftman et al. (“Hoftman”). Applicants submit these rejections should be withdrawn.

Koros describes a lumbar spinal fusion retractor and distractor system having fixed distractor blades 50, 52 which individually receive screws 54, 56 in slots/channels 58, 60 to firmly hold distractor blades 50, 52 in place on vertebrae 72, 74. (*See* Koros at 4:49-59, Figs. 3-4). Vertebrae 72, 74 can be spread apart by crank 48 to spread distractor blades 50, 52. (*See id.* at 4:62-65). Examiner correctly notes that Koros does not teach one distractor blade moveably coupled to another distractor blade. (*See* Non-Final Office Action mailed

3/31/06 “Office Action” at 3). Hoftman describes a rotational lateral expander device having movable base plates 200A, 200B, 220A, 220B. (See Hoftman at Fig. 7).

Independent claim 1 recites a retractor system comprising “a first tissue retaining wall coupled to a first guide receiving channel; and a second tissue retaining wall movably coupled to the first tissue retaining wall.” Koros does not describe, and Examiner agrees, “a second tissue retaining wall movably coupled to the first tissue retaining wall,” wherein the first tissue retaining wall is “coupled to a first guide receiving channel.” However, the Examiner argues that it would be obvious to modify the device in Koros in light of Hoftman to make distractor blade 50 “movably coupled” to distractor blade 52. (Office Action at 3-4).

Examiner’s argument fails on two fronts. First, the Examiner has pointed to no teaching, suggestion, or motivation to modify the Koros device in light of Hoftman. The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness, unless the prior art also suggests the desirability of the combination. See MPEP § 2143.01(III). Koros does not suggest the desirability of modifying either distractor blade 50, 52 to be movably coupled to the other. Koros instead teaches just the opposite — distractor blades 50, 52 are *fixed* in vertebrae 72, 74 to firmly hold the distractor 12 in place. (See Koros at 4:6-13, 49-59). Hoftman does not suggest the desirability of modifying Koros either, as Hoftman fails to describe a guide receiving channel.

Second, there is no teaching, suggestion, or motivation to modify the Koros device because doing so be contrary to its purpose. As expressly stated in Koros: “[s]crews 54 and 56 are fed through lengthwise slots 58 and 60, in blades 50 and 52, and firmly hold distractor frame 20 and blades 50 and 52 in place with adjacent vertebrae spread or distracted during operation on a lumbar disc.” (Koros at 4:8-13). “Screws 54 and 56 are screwed into predrilled holes in adjacent vertebrae 72 and 74, firmly holding distractor blades 50, 52 in place.” (*Id.* at 5:55-58) Modifying one of the distractor blades 50, 52 to be moveably coupled is opposite the avowed purpose of the distractor blades 50, 52 to provide a steady and firm foundation for the distractor frame 20.

Independent claim 20 recites a method of inserting a tissue retractor comprising “percutaneously implanting first and second guides; positioning upper ends of the first and second guides through the first and second guide receiving areas, respectively, thereby inserting the retractor; and moving the tissue retracting surfaces apart from one another independently of the first and second guides.” Neither Koros nor Hoftman describe a method of inserting a retractor having tissue retracting surfaces over guides, and moving the

tissue retracting surfaces apart independently of the guides. In Koros, any movement of the distractor blades 50, 52 after screws 54, 56 are inserted into channels 58, 60, must necessarily move the respective screw 54, 56 along with the moved distractor blade 50 or 52. Hoftman fails to remedy the deficiencies of Koros, as Hoftman does not teach, suggest, or describe a guide or guide receiving channel.

Accordingly, as Koros and Hoffman, either singly or in combination, fail to teach, suggest, or disclose each and every element of claims 1 and 20, the rejections of those claims should be withdrawn. Similarly, as dependent claims 2-7, 11, 14, 15, 17-19 depend from independent claim 1, and dependent claims 21-23 depend from independent claim 20, the rejections of those claims should also be withdrawn, for at least that reason.

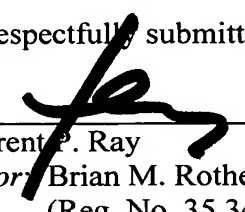
### CONCLUSION

It is believed claims 1-23 are in condition for allowance. Should Examiner not agree with any of Applicant's positions or arguments herein, a telephonic or personal interview is respectfully requested to discuss and resolve any remaining issues.

A two-month extension fee of \$450 is believed due for this response. Please charge this fee, and any additional fee(s) that may be due, to Jones Day Account No. 503013.

Respectfully submitted,

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